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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,209	10/01/2003	Noel P. Horkan	HOR 101	9682
7590	04/12/2005		EXAMINER	
James Russell Claybrook P. O. Box 843 New Hampton, NY 10958			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/676,209	HORKAN, NOEL P.	
	Examiner	Art Unit	
	Mitra Aryanpour	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-18 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

As a courtesy to applicant the claims have been examined on the merits. However, it should be noted that the Amendment document filed on 12 January 2005 should have been considered as non-compliant, because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, June 20, 2003). In order for the amendment document to have been compliant, a complete listing of all of the claims should have been presented and each claim should have been provided with the proper status identifier, and as such, the individual status of each claim is not correctly identified. The application as filed contained only claims 1-9. Claims 10-18 are newly added claims. Therefore, they should be identified as (new) not as (currently amended) or (previously presented). Additionally, the newly added claims should not have been underlined. It is requested that in response to this Office Action, appropriate correction is made to the pending claims in order to meet the requirements of 37 CFR 1.121.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification as filed does not support the newly claimed limitation "patch or

patches having a diameter not greater than two inches". Additionally, it is not readily apparent from the Drawings or the Specification as filed that the patches should be circular.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 12, 13, 17 and 18, it is important to recognize that a Trademark or Trade Name is used to identify a source of goods, and not the good themselves. Thus a Trademark or Trade Name does not identify or describe the goods associated with the Trademark or Trade Name. See definitions of Trademark and Trade Name in MPEP 608.01(v). A Trademark or Trade Name used in a claim as a limitation to identify or describe a particular material or product does not comply with the requirements of 35 USC 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the Trademark or Trade Name cannot be used properly to identify any particular material or product. In fact, the value of the Trademark or Trade Name would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a Trademark or Trade Name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the Trademark or Trade Name. If the Trademark or Trade Name appears in a claim and is not intended as a limitation in the claim, then the question of why it is in the claim arises and whether or not its presence causes

confusion as to the scope of the claimed subject matter. Trademarks cannot be claimed. In order to avoid the above 112 rejection, "VELCRO" should be taken out of the claim language.

5. Claim 10 recites the limitation "the fingerpads" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim. Since there is no prior reference of "fingerpads" in the claim, "the" should be deleted before fingerpads. The use of 'the' infers that there is a prior reference to fingerpads.

6. Claim 15 recites the limitation "the fingerpads" in line 8. There is insufficient antecedent basis for this limitation in the claim. Since there is no prior reference of "fingerpads" in the claim, "the" should be deleted before fingerpads. The use of 'the' infers that there is a prior reference to fingerpads.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turangan (5,316,294) in view of Rudell et al (5,195,745).

Regarding claim 10, Turangan shows a football kicking training aid comprising in combination: a football (21) having at least one attached patch (fastener 43), said patch or patches covering one or both pointed ends of said football (see figures 4 and 5 at ends 30 and 32), said patch or patches having a plurality of either male or female fastener elements thereon (loop fastener 43); a flexible glove (10) having lateral areas positioned adjacent the finger pads

(hook fasteners 44) of a user wearing said glove (10); a pad on the said lateral area of the index finger of said glove (see figure 2), said pad having a plurality of mating fastener elements thereon complementary to said fastener elements on said patch, said mating elements on said glove worn by a user releasably engaging said mating elements on said patch located at the upper end of said football (see figures 2 and 3), whereby said mating of said complementary fastener elements urges a user to properly support said football. Turangan does not disclose expressly substituting a thimble for the gloves. Rudell et al shows a throwing projectile such as a football (10, 19 or 42) having a plurality of patch(s) (VELCRO tab 44) and corresponding glove (34), wrist strap (28) or finger band (67) having a plurality of patches (tab 25, 26; 41; 88) worn by each user. Rundell et al shows that the patch(es) is positioned on the object so that when the object is held in typical fashion, there is interaction between the VELCRO on the glove and the VELCRO on the object. In view of Rudell et al it would have been obvious to select any one of the hand/finger coverings to use with the football of Turangan, since one of ordinary skill in the art, would have expected Turangan's invention to perform equally well with anyone of the above hand/finger coverings, because they all perform the same function of protecting the hand and fingers from the football and provide a means for gripping the football. Therefore, it would have been an obvious matter of design choice to modify Turangan to obtain the invention as specified in claim 10. With regards to the patch(s) not having a diameter greater than two inches, as best seen from the figures the diameter of the patch(es) do not appear to be not greater than 2 inches. With regards to the limitation "...said patch only at said upper end..." as best understood, the Turangan device could be contacted only at the upper end if the user so chooses. This is a functional step.

It should be noted: a recitation of the intended use, in the instant case *for kicking by another player, at said patch at said upper end by a user's finger pad within said glove, and to continue supporting said football until the kicking action has been completed* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 11, Turangan shows said mating fastener elements disengage from said complementary mating elements upon a player handling said football.

Regarding claims 12 and 13, Turangan shows said mating elements on said patch or patches comprise hook (44) loop (43) elements (column 2, lines 46-53).

Regarding claim 14, Turangan shows the material of said glove is formed of an elastic material, which would include natural and/or synthetic rubber.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Turangan (5,316,294).

Regarding claim 15, Turangan discloses a football kicking training aid comprising in combination: a football (21) having at least one attached patch (fastener 43), said patch or patches covering one or both pointed ends of said football (see figures 4 and 5 at ends 30 and 32), said patch or patches having a plurality of either male or female fastener elements thereon (loop fastener 43); a flexible glove (10) having a plurality of fingers (44), said fingers having lateral areas positioned adjacent the finger pads (hook fasteners 44) of a user wearing said glove (10); a pad on the said lateral area of the index finger of said glove (see figure 2), said pad having a plurality of mating fastener elements thereon complementary to said fastener elements on said patch, said mating elements on said glove worn by a user releasably engaging said mating elements on said patch located at the upper end of said football (see figures 2 and 3), whereby said mating of said complementary fastener elements urges a user to properly support said football. With regards to the patch(s) not having a diameter greater than two inches, as best seen from the figures the diameter of the patch(es) do not appear to be greater than 2 inches.

It should be noted: a recitation of the intended use, in the instant case *for kicking by another player, at said patch at said upper end by a user's finger pad within said glove, and to continue supporting said football until the kicking action has been completed* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 16, note the rejection of claim 2.

Regarding claim 17, note the rejection of claim 3.

Regarding claim 18, note the rejection of claim 4.

Response to Arguments

11. Applicant's arguments filed 12 January 2005 have been fully considered but they are not persuasive. With regards to applicant's remarks that the claims have overcome the 112 2nd rejections directed to the use of Trademarks in claims. Such is not the case. Trademarks cannot be claimed. In order to avoid the above 112 rejection, "VELCRO" should be taken out of the claim language.

With regards to applicant's remarks that the claims have overcome the 112 2nd rejections directed to improper antecedent basis. Again such is not the case. There is no prior reference of "fingerpads" in the claim, "the" should be deleted before fingerpads. The use of "the" infers that there is a prior reference to fingerpads.

With regards to applicant's assertion that the 102 rejection of claims 6-9 (now claims 15-18) being inaccurate. As indicated above Turangan's device meets the structural limitation of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

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With regards to applicant's remarks that the device of Turangan features extensive rather than restricted coverage of the glove and football with hook-and-loop material. The claims as presented do not limit coverage only to the tip, but rather state that it should have at least one attached patch at one or both pointed ends. Applicant has not disclosed in the Specification as filed that the patches should be of a specific shape or size.

With regards to the interpretation of "patch". Applicant has not defined the specific size of the claimed patch in this application as filed. the broadest reasonable interpretation of a patch would include a patch as small as 1mm to the full length of a football.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

The Specification as filed does not support the newly claimed limitation "patch or patches having a diameter not greater than two inches". Additionally, it is not readily apparent from the Drawings or the Specification as filed that the patches should be circular or not greater than 2 inches.

With regards to applicant's assertion that Rudell et al teaches away from placing the patches on one or both ends of a football. The Rudell et al reference was applied only to demonstrate that there is nothing unobvious about using a glove, a wrist ban or a finger band to place a VELCRO. Therefore, applicant's arguments are moot. For the record, Rudell et al shows that the patch(es) is positioned on the object so that when the object is held in typical fashion, there is interaction between the VELCRO on the glove and the VELCRO on the object. It is

unclear how applicant came to the conclusion that it teaches away from placing the VELCRO patch on the tip(s). In the event the ball of Rudell et al was used in kicking practice, then it appears that the VELCRO patch would have been positioned on the tip(s), since Rudell et al teaches that the patch(es) are positioned on the object so that it can be held in a typical fashion, and it appears that a typical fashion for kicking a ball would be holding it at the top tip.

Would regards to applicant's assertion that neither Turangan nor Rudell et al teach the use of thimbles. The broadest reasonable interpretation of a thimble would include the finger band taught by Rudell et al.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rudell et al teaches that VELCRO tabs can be attached to any one of a glove, wrist band or finger band and there is nothing unobvious about using the same for handling the device of Turangan.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

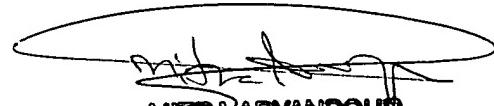
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
25 March 2005



MITRA ARYANPOUR
PRIMARY EXAMINER